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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,549	06/19/2001	Michael J. Lemon	10007916-1	2371

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Intellectual Property Administration
P.O. Box 272400
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EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
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2697

3

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,549

Applicant(s)

LEMON, MICHAEL J.

Examiner

Ming-Hun Liu

Art Unit

2697

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being unpatentable by US Patent 6,525,716 to Makino.

In reference to claim 1, Makino discloses a similar computer annotator system comprising an electronic tablet (figure 1, item 3) having visible marking capability, a marking stylus associated with the tablet (column 3, line 62), a device for associating at least one temporarily marked location on the tablet with a preselected data address wherein subsequently accessing the marked location with the stylus triggers a shift data address associated with the marked location (column 2, lines 1-9).

Referring to claims 2 and 3, the tablet having at least one predetermined first surface region accessible to the stylus wherein annotating function commands are implemented. The tablet also has at least one predetermined second surface region accessible to the stylus wherein free-form images indicative of the preselected data address are entered (column 1, line 56-58).

In reference to claim 4, the tablet is connected to a computer-like apparatus for accessing said preselected data address (column 4, lines 46-50), where the data address is selected from a group from documents, files or applications (column 4, lines 29-35).

Claims 5 is rejected on the same grounds used in the rejection of claims 1-3 since this claimed method is the one used by the system described in claims 1-3.

In reference to claim 6, Makino allows for the method to accommodate for a plurality of computer-accessible sites other the aforementioned first computer-accessible site and second computer-accessible site as long as there is available space for further visible marking (column 1, line 56-58 and figure 22).

The limitations of claim 8 resemble those of claims 1 and 5, thus are rejected on similar grounds. The new limitations of claim 8, writing a mnemonic object associated with the computer data address being accessed is also anticipated by Makino. Instead of labeling the handwriting a mnemonic, Makino describes the writings as codes that correspond to an action to be performed on the data address (column 2, lines 5-10).

In reference to claim 9, in his invention, Makino clearly predefines specific locations on said tablet with data indexing functions (column 2, lines 13-23).

3. Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,057,845 to Dupony.

In reference to claim 15, Dupony discloses a computer memory comprising a computer code for recording temporary symbols and associating an address of preselected computer data with a writable-erasable mnemonic device in a computer writing tablet for receiving said temporary symbols (column 2, lines 15-36).

Claim 16 is also anticipated by Dupony on column 4, lines 31-37. Dupony allows for the case where the memory set forth in claim 15 comprises computer code for accessing addresses,

wherein the address is selected from a gamut of applications and operating systems as depicted in claim 16.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Makino and US Patent 4,633,436 to Flurry. Makino describes a method that resembles the claimed invention, however never explicitly stated the incorporation of a method for erasing a visible making on the writing tablet after a last access to an associated address indicative of a computer-accessible site. As seen in Flurry's invention (column 2 lines, 39-43) the erase capability of writing tablets has been a concept well known in the art. It would have been obvious to one skilled in the art to include an erasing capability to Makino's invention so that users may be able to modify or completely disassociate an address to a computer-accessible site would.

6. Claims 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dupony.

In reference to claim 11, Dupony discloses a computerized method comprising accessing a computer program and associating a function with a writable-erasable mnemonic device in a

computer writing tablet (column 2, lines 15-36). Dupony never specifically states that the method be used while accessing an internet site, nor did he state that the mnemonic must be associated with an address of the site, but his universal symbolic generator accounts for such a case because Dupouy says "the user can customize the same input so that it will initiate different, but fully definable actions" (column 2, lines 24-26). This is a clear suggestion that a user can use whatever function as desired. Designating an Internet address is a common computing and Internet function.

Referring to claim 12, the method also includes writing table function keys associated with writing-erasing a mnemonic device on said computer writing tablet (column 11, lines 18-21).

In reference to claim 14, the method also automatically alternating access between a plurality of addresses accessed and associated with mnemonic devices by alternating current selection between the mnemonic devices with a writing tablet writing instrument (column 5, lines 5-12).

Claims 17 and 18 are rejected on the same grounds as claims 11 and 12.

Claim 20 is rejected on the same grounds as claims 14.

7. Claims 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dupony and Makino.

Dupony's method resembled closely to the method set forth in claim 11, however Dupony never accounted for the case where the mnemonic device is automatically associated with one of said predetermined coordinate regions when entered therein. Makino, as mentioned

above, does associate handwritten symbols along with the region of the tablet. It would have been obvious to combine the two inventions, including associating the location as well as the symbol to the address of the site.

Claim 19 is rejected on the same grounds as claims 13.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on 703-305-3885. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

Ming-Hun Liu
April 7, 2003



MIN-HUN LIU
APR 7 2003